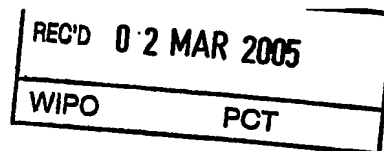


INTERNATIONAL PRELIMINARY EXAMINATION REPORT  
(PCT Article 36 and Rule 70)



Applicant's or agent's file reference TSL1808PCT		<b>FOR FURTHER ACTION</b> See Notification of Transmittal of International Preliminary Examination Report (Form PCT/PEA/416)
International application No. PCT/JP 03/14608	International filing date (day/month/year) 17.11.2003	Priority date (day/month/year) 29.11.2002
International Patent Classification (IPC) or both national classification and IPC C08K3/08		
Applicant DOW CORNING TORAY SILICONE CO., LTD. et al.		

1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.


2. This REPORT consists of a total of 5 sheets, including this cover sheet.

☐ This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).

These annexes consist of a total of sheets.

3. This report contains indications relating to the following items:

- I ☒ Basis of the opinion
- II ☐ Priority
- III ☐ Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- IV ☐ Lack of unity of invention
- V ☒ Reasoned statement under Rule 66.2(a)(ii) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- VI ☐ Certain documents cited
- VII ☐ Certain defects in the international application
- VIII ☐ Certain observations on the international application

Date of submission of the demand  19.06.2004	Date of completion of this report  28.02.2005
Name and mailing address of the international preliminary examining authority:   European Patent Office D-80298 Munich Tel. +49 89 2399 - 0 Tx: 523656 epmu d Fax: +49 89 2399 - 4465	Authorized Officer  Dury, O  Telephone No. +49 89 2399-8313



**INTERNATIONAL PRELIMINARY  
EXAMINATION REPORT**

International application No. PCT/JP 03/14608

**I. Basis of the report**

1. With regard to the **elements** of the international application (*Replacement sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to this report since they do not contain amendments (Rules 70.16 and 70.17)*):

**Description, Pages**

1-21 as originally filed

**Claims, Numbers**

1-10 as originally filed

2. With regard to the **language**, all the elements marked above were available or furnished to this Authority in the language in which the international application was filed, unless otherwise indicated under this item.

These elements were available or furnished to this Authority in the following language: , which is:

- ☐ the language of a translation furnished for the purposes of the international search (under Rule 23.1(b)).  
☐ the language of publication of the international application (under Rule 48.3(b)).  
☐ the language of a translation furnished for the purposes of international preliminary examination (under Rule 55.2 and/or 55.3).

3. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application, the international preliminary examination was carried out on the basis of the sequence listing:

- ☐ contained in the international application in written form.  
☐ filed together with the international application in computer readable form.  
☐ furnished subsequently to this Authority in written form.  
☐ furnished subsequently to this Authority in computer readable form.  
☐ The statement that the subsequently furnished written sequence listing does not go beyond the disclosure in the international application as filed has been furnished.  
☐ The statement that the information recorded in computer readable form is identical to the written sequence listing has been furnished.

4. The amendments have resulted in the cancellation of:

- ☐ the description, pages:  
☐ the claims, Nos.:  
☐ the drawings, sheets:

5. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)).

*(Any replacement sheet containing such amendments must be referred to under item 1 and annexed to this report.)*

6. Additional observations, if necessary:

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**V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability;  
citations and explanations supporting such statement**

1. Statement

Novelty (N)	Yes: Claims	N yes: 5-10
	No: Claims	N no: 1-4
Inventive step (IS)	Yes: Claims	IS yes: 5-10
	No: Claims	IS no: 1-4
Industrial applicability (IA)	Yes: Claims	IA yes: 1-10
	No: Claims	

2. Citations and explanations

**see separate sheet**

**Concerning Paragraph V**

**1. Relevant document:**

- D1: JP-A-58 104 970 (cited in the application)
- D2: JP-A-58 103 565 (cited in the application)
- D3: EP-A-0 647 682
- D4: EP-A-0 545 568
- D5: EP-A-0 144 741

**2. Novelty: Art. 33(2) PCT**

2.1 a) Although the silver powders have been defined using a "product by process" formulation, the subject matter of claims 1-2 is the product per se, namely the suspension comprising the cryogrounding polymer. The by-process element of this claim is given no patentable weight unless and until the applicants demonstrates/makes plausible that the product of the present claim 1-2 differs from those of D1-D2.

b) D1 discloses a method of coating the silver based powders with benzotriazole comprising kneading together silver particles and a solution of benzotriazole in a solvent. Considering that the term "applying mechanical energy" of claim 3 is vague and comprising such a process as "kneading" the subject matter of claims 3-4 is not novel.

c) Since D1-D2 -cited in the application- were only provided as an abstract to the examining division it can not be decided up to now whether D1-D2 anticipate further subject matter claimed or not. Should the application enter the regional European phase and in order to allow a final assessment and to streamline the proceedings the applicant is kindly asked to provide a translation of D1-D2.

2.2 a) D3 discloses the same curable silicon compositions comprising silver based powders which are coated with an organosilicon compound. A cure inhibitor such as benzotriazole may be present in the compositions. D3, however, does not disclosed silver powders coated with antioxidants or silicon compositions containing these powders.

b) Same is valid for the silver based powders coated with opt. esterified fatty acid and silicon compositions comprising these powders according to D4.

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c) D5 discloses metal powders coated with a compound which prevent/inhibit the metal powder to induce the polymerisation of cyanoacrylates. The metal may be silver. The compounds used for coating are, however, no antioxidants according to claims 1-4 on file. D5 also does not disclose silicon compositions according to claims 5-10 on file.

d) The subject matter of claims 1-10 is novel over D3-D4

**3. Inventive step: Art. 33(3) PCT**

It appears that the skilled person starting from D3 as closest prior art would have found no incentive to coat the silver particles with antioxidants according to claims 5-10 in order to provide curable silicon compositions exhibiting improved storage properties without affecting their curability (see results of Table 1; comp. ex. 1 and 3 may be seen as illustrative of D4 and D3, resp.). The subject matter of claims 5-10 may be acknowledged an inventive merit.

4. The subject matter of claims 1-10 is industrially applicable.